

E-FILED on 4/13/07

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION

MEMRY CORPORATION,

Plaintiff,

v.

KENTUCKY OIL TECHNOLOGY, N.V.,  
PETER BESSELINK, MEMORY METALS  
HOLLAND, B.V.,

Defendants.

No. C-04-03843 RMW

ORDER REQUESTING KOT'S RESPONSE  
TO STC'S OBJECTION TO MAGISTRATE  
JUDGE'S MARCH 19, 2007 ORDER

[Re Docket No. 558]

KENTUCKY OIL TECHNOLOGY, N.V.,

Counterclaimant,

v.

MEMRY CORPORATION and  
SCHLUMBERGER TECHNOLOGY  
CORPORATION,

Counterdefendants.


Counterdefendant Schlumberger Technology Corporation ("STC") filed a motion to compel production against defendant and counterclaimant Kentucky Oil Technology ("KOT"). STC sought to

1 compel production of an intellectual property evaluation conducted by attorney Nicola Pisano<sup>1</sup> in 2003  
 2 on behalf of Jomed, a predecessor in interest to KOT. The magistrate judge assigned to this case denied  
 3 STC's motion to compel in an order dated March 19, 2007 ("Order") after determining that the  
 4 evaluation was protected by the work-product doctrine and that STC had not shown substantial need  
 5 because the evaluation would only be corroborating evidence.

6 STC asks this court to review the Order because the magistrate judge did not review the  
 7 privileged materials in dispute *in camera*. STC argues that because KOT offered to make the disputed  
 8 materials available for *in camera* review, it was error for the magistrate judge not to undertake such a  
 9 review in light of the judge's determination that the information STC sought to compel "is not an  
 10 essential element of STC's prima facie case." Order at 4. STC contends that the evaluation may contain  
 11 a party admission or prior inconsistent statements that would not be otherwise available through  
 12 witnesses previously deposed, and would thus be more than corroborating evidence. *In camera* review,  
 13 according to STC, would have permitted the magistrate judge to determine whether the evaluation  
 14 would provide evidence beyond that which is merely corroborating.

15 The court shall permit KOT to file a brief of no longer than seven pages in opposition to STC's  
 16 objection by Monday, April 23, 2007. STC shall not be entitled to file a reply. Thereafter the matter  
 17 will be deemed submitted on the papers.

18  
 19  
 20 DATED: 4/9/07

  
 RONALD M. WHYTE  
 United States District Judge

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 28 <sup>1</sup> Pisano is KOT's patent prosecution, transaction and litigation counsel in this matter.  
 She is also a witness.

1 **Notice of this document has been electronically sent to:**

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16 Counsel are responsible for distributing copies of this document to co-counsel that have not registered  
17 for e-filing under the court's CM/ECF program.

18 **Dated:** 4/13/07

19 /s/ MAG  
20 **Chambers of Judge Whyte**